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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) N0389.70005US00	
		Application Number 09/785,630-Conf. #3560	Filed February 16, 2001
		First Named Inventor Alex Magary et al.	
		Art Unit 3692	Examiner F. Poinvil

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

- ☐ applicant /inventor.
☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)

☒ attorney or agent of record.

Registration number 35,986

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34.

Randy J. Pritzker
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11-13-08
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

☐ *Total of 1 forms are submitted.

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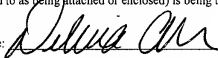
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Dated: 11-13-08

Signature: Delina A. Andriolo (Delina A. Andriolo)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Alex Magary et al.
Serial No.: 09/785,630
Confirmation No.: 3560
Filed: February 16, 2001
For: METHOD AND APPARATUS FOR PROVIDING
FINANCIAL TRANSACTION DATA VIA THE
INTERNET
Examiner: F. Poinvil
Art Unit: 3692

Certificate of Electronic Filing Under 37 CFR 1.8	
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Dated: 11-13-08	Signature:  (Delfina A. Andriolo)

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PRE-APPEAL BRIEF REQUEST FOR REVIEW

In response to the Final Office Action mailed May 13, 2008, Applicant respectfully requests review prior to the filing of an Appeal Brief.

The Office Action rejects claims 17-50, 59-74 and 83-118 under 35 U.S.C. §103(a) as purportedly being obvious over U.S. Patent No. 6,128,630 to Dent, et al. ("Dent"). The claim rejections are clearly improper for failing to observe several explicit requirements set forth by the MPEP. Specifically, the Office Action (1) fails to explain how each claim limitation is believed to be satisfied by the asserted reference, or the proposed modification to the asserted reference necessary to arrive at the claimed subject matter, as required under MPEP §706.02(j); (2) fails to answer all material traversed by Applicant, as required under §707.07(f); and (3) fails to cite all references relied upon in rejecting the claims, as required under MPEP §707.05. In addition, even if all relevant MPEP provisions were satisfied, the contentions regarding how the claim limitations are believed to be satisfied lack any support

in the references. As such, the Office Action also fails to set forth a *prima facie* case of obviousness. For each of these reasons the rejections are improper and should be withdrawn.

I. The Office Action Fails Comply With The Provisions Of MPEP §706.02(j)

MPEP §706.02(j) requires that the Office Action indicate how each claim limitation is believed to be satisfied by the asserted reference, and explain the proposed modification to the asserted reference necessary to arrive at the claimed subject matter. The Office Action satisfies neither of these requirements.

Each of independent claims 17, 34, 59, 83 and 114 includes limitations directed to, *inter alia*, determining a unique identifier for each of a plurality of distinct financial transactions, and **determining, as a function of each unique identifier, whether an associated client has consented to receiving respective financial transaction data electronically**. The Office Action is completely devoid of any indication as to how these limitations are believed to be satisfied. Specifically, while the Office Action includes a number of (unsupported) contentions regarding the existence in the prior art of financial transactions having unique identifiers (p.3), and transaction data being made available to a client as desired (p. 5), the Office Action simply fails to point to any disclosure or suggestion in the prior art of determining, as a function of a unique identifier for each of a plurality of distinct financial transactions, whether an associated client has consented to receiving respective financial transaction data electronically. The Office Action thus fails to indicate how each claim limitation is believed to be satisfied, as required under MPEP §706.02(j).

The Office Action also fails to explain the proposed modification to Dent which is necessary to arrive at the claimed subject matter. In this respect, the Office Action appears to rely on Dent to satisfy only certain of the claim limitations, but fails to explain which limitations are believed to be satisfied by Dent and which are satisfied by other (unspecified, as discussed below) purported prior art references. As a result, it is impossible for Applicant to even determine, let alone respond to, the modifications which the Office Action proposes to make to Dent to arrive at the claimed subject matter. For each reason discussed above, the

rejections are clearly improper and should be withdrawn.

II. The Office Action Fails to Comply With The Provisions Of MPEP §707.07(f)

MPEP §707.07(f) requires that the Office Action answer all material traversed by Applicant. Specifically, when Applicant traverses any rejection, the Examiner is required to take note of the argument and answer the substance of it if the rejection is to be maintained. The Office Action simply fails to do so, and instead merely repeats rejections verbatim.

In Applicant's previous response filed March 20, 2008, it was pointed out that Dent fails to disclose or suggest determining, as a function of a unique identifier for each of a plurality of distinct financial transactions, whether an associated client has consented to receiving respective financial transaction data electronically, as required by each of independent claims 17, 34, 59, 83 and 114 (p. 21). Specifically, Applicant pointed out that the entirety of Dent, which discloses a consumer bill management/payment system which receives, manages and pays bills received electronically via the Internet (Abstract), presumes that a user has given consent to electronic notification of bills received, so that no determination regarding the user's consent to electronic delivery is performed. As such, it was pointed out that Dent necessarily fails to disclose or suggest determining, as a function of a unique identifier for each of a plurality of distinct financial transactions, whether an associated client has consented to receiving respective financial transaction data electronically, as required by each of independent claims 17, 34, 59, 83 and 114.

The Office Action simply fails to answer this argument, and instead merely repeats the same rejection verbatim without addressing the substance of Applicant's point. For this additional reason, the rejections are improper and should be withdrawn.

III. The Office Action Fails to Comply With The Provisions Of MPEP §707.05

MPEP §707.05 requires that the Office Action cite the prior art which is believed to be nearest to the claimed subject matter, and explain its relevance to the rejection. The Office Action instead apparently bases the claim rejections in large part upon unsubstantiated contentions regarding systems and arrangements which the Examiner

believes were in existence at the time of the invention.

For example, with respect to claim limitations requiring a unique identifier for each of a plurality of distinct financial transactions, the Office Action contends (p.3):

Furthermore, it should be noted that a bank's monthly statement includes a plurality of individual financial transactions having unique identifiers. Thus, these financial transactions include unique identifiers and purchasers names and/or codes and or addresses associated with each given transaction.

With respect to Applicant's argument that the prior art of record fails to disclose or suggest obtaining consent to send financial transaction data electronically, the Office Action states (p. 5):

While the Internet has been in existence for many years, there are a number or millions of people who reject to conduct online business or transactions because of the lack of computer knowledge or because of the fear of hackers. Thus, from this knowledge, it would have been obvious to one of ordinary skill in the art to make the transaction data available to a client as desired.

The Office Action provides no support whatsoever for these bare, unsubstantiated statements, and provides no evidence that either arrangement described constitutes prior art under 35 U.S.C. §102. These statements therefore amount to nothing more than the Examiner's speculation regarding the content of the prior art. For this additional reason, the rejections are improper and should be withdrawn.

IV. Each Claim Patentably Distinguishes Over The Prior Art Of Record

Even if the Office Action did comply with all relevant MPEP provisions, each independent claim patentably distinguishes over the prior art of record.

Each of independent claims 17, 34, 59, 83 and 114 includes limitations directed to determining, as a function of a unique identifier for each of a plurality of distinct financial transactions, whether a client has consented to receiving financial transaction data electronically. Independent claims 100 and 107 each include limitations directed to,

inter alia, obtaining consent from a user to provide financial transaction data electronically to the user. Dent fails to satisfy these limitations. Dent discloses a system which *by default* informs the user electronically when a bill arrives (e.g., via a pop-up dialogue box, by waking up the user interface, or by launching the application) (col. 5, line 64 – col. 6, line 38). In a passage cited by the Office Action, Dent discloses that an “opt out” capability whereby the user may elect to be notified using non-electronic means (e.g., telephone, fax, etc.) (col. 6, lines 39-53). Thus, Dent discloses allowing a user to specify that he/she would not like to be notified electronically when a bill arrives. Dent does not disclose or suggest determining whether the user has consented to receiving financial transaction data electronically, as required by 17, 34, 59, 83, 100, 107 and 114. Dent certainly says nothing about doing so as a function of a unique identifier for each distinct financial transaction, as required by claims 17, 34, 59, 83 and 114.

V. Conclusion.

For each of the foregoing reasons, the rejection of each of claims 17, 34, 59, 83, 100, 107 and 114, and of the claims that depend respectively therefrom, is improper and should be withdrawn.

Date: 11-13-08

Respectfully submitted,

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